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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,170	02/01/2000	Jeffrey Delaney	109140-0001	5831

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary

Application No.

09/496,170

Applicant(s)

DELANEY ET AL.

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 5-7, 9, 12, 33, 37-38, 40 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by **Ball et al.** (US 6,393,107).

As to Claims 1, 5, 7, 37-38, 43, with respect to Figures 1-4, **Ball** teaches a messaging system comprising:

a. a message server, 104, comprising a plurality of modalities for transmitting messages (Figure 3);

b. an interface for receiving a message and a designation of at least some of the transmission modalities (Figure 1, label 101);

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c. a memory for storing escalation rules specifying sequential transmission of the message by means of each of the designated modalities upon occurrence of a specified condition (Col. 7, lines 64-65 and Figure 3); and

d. a routing facility, responsive to the escalation rules and to the occurrence of the conditions, for causing the message to be sequentially transmitted by the message server in accordance with the escalation rules (Figure 3).

As to Claim 6, **Ball** teaches the system of claim 1 wherein the interface comprises means for receiving escalation rules from a message sender (Col. 4, lines 34-39).

As to Claims 9,40, **Ball** teaches the system of claim 1 wherein the interface is further configured to receive, from a message sender, a list of recipients for the message and escalation rules for each recipient, the routing facility causing the message to be transmitted to each recipient by the message server in accordance with the escalation rules (Figure 3).

As to Claim 12, with respect to Figures 1-4, **Ball** teaches a messaging system comprising:

a. a message server comprising a plurality of modalities for transmitting messages (Figure 1 label 104);

b. an interface for receiving a message comprising a plurality of segments encoded in different formats, and a designation of at least some of the transmission modalities (Figure 2, label 204);

c. an analysis facility for (i) determining the segment formats,

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(ii) identifying, from among the designated transmission modalities, the modalities appropriate to the segments (Figure 2, label 204), and

(iii) composing the segments into messages suitable for transmission by the identified modalities (Figure 2, label 204); and

d. a routing facility for causing at least some of the composed messages to be transmitted by the identified modalities (Figure 1 and Figure 2, labels 205-206).

As to Claim 33, with respect to Figures 1-4, **Ball** teaches a method of transmitting messages, the method comprising the steps of:

a. receiving a message and a designation of at least some of a plurality of transmission modalities (Col. 9, lines 22-30 and Figure 3);

b. storing escalation rules specifying sequential transmission of the message by means of each of the designated modalities upon occurrence of a specified condition (Col. 7, lines 64-65); and

c. causing the message to be sequentially transmitted in accordance with the escalation rules (Col. 7, lines 64-65).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 30-32 and 60-62 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Brown et al.** (US 4,972,461).

As to Claims 30,60, with respect to Figures 1-6, **Brown** teaches a messaging system comprising:

- a. a CDS (message server) comprising a plurality of communication modalities for transmitting messages, the modalities including telephony, the message server comprising a telephony server (Figure 1, Col. 4, lines 37-45 and Col. 15, lines 62-67);
- b. an interface for receiving a message and a designation of at least one of the communication modalities (Figure 1, label 131 and Col. 4, lines 61-65, Col. 5, lines 13-22);
- c. a routing facility, responsive to the designation, for causing transmission of the message by means of the designated modalities (Col. 12, lines 38-51); wherein
- d. the telephony server is configured to discriminate between individuals and telephone-answering devices, and to detect receipt of the message by an individual (Col. 15, line 65 through Col. 16, line 6).

As to Claims 31,61, **Brown** teaches the system of claim 30 wherein the interface is configured to report receipt of the message by an individual (Col. 15, lines 10-23).

As to Claims 32,62, **Brown** teaches the system of claim 30 wherein the telephony server is configured to append to the message, upon detection of a telephone-answering device, instructions for subsequently establishing a telephone connection to the telephony server to confirm receipt of the message (Col. 15, lines 24-32 and Col. 16, lines 1-6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 16, 19, 34 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ball** in view of **Brown et al.** (US 4,972,461).

As to Claims 2,34, **Ball** teaches the system of claim 1:

Ball does not teach the following limitation:

“wherein the condition associated with at least some of the modalities is non-receipt of the message transmitted via said modalities”

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However, it is obvious that **Ball** suggests the limitation. This is because **Ball** teaches receiving a subset of responses (Col. 23, lines 12-14). **Brown** teaches unsuccessful notification of message delivery (Figure 6, label 616). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add unsuccessful delivery capability to **Ball's** invention in order to provide user control of message delivery.

As to Claims 16,19,47, with respect to Figures 1-4, **Ball** teaches a messaging system comprising:

- a. a message server comprising a plurality of modalities for transmitting messages (Figure 1, label 104 and Figure 3);
- b. an interface for receiving a message and a designation of at least one of the transmission modalities (Figure1, label 101) ;
- c. a memory for storing scheduling criteria governing use of the at least one designated modality (Figure 1, label 104 and Col. 9, line 32 through Col. 10, line 2); and
- d. a routing facility, responsive to the scheduling criteria, for causing transmission of the message by means of the at least one designated modality in accordance with the scheduling criteria therefore (Figure 3 and Col. 10, lines 3-14);

Ball does not teach the following limitation:

“scheduling criteria”

However, it is obvious that **Ball** suggests the limitation. This is because **Ball** teaches sending customized messages to recipients (Col. 9, lines 22-30). **Brown** teaches a customized schedule for delivering messages to recipients (Figure 3, label 312). Having the cited art at the

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time the invention was made, it would have been obvious to one of ordinary skill in the art to add scheduling capability to **Ball's** invention in order to provide user control of message delivery.

8. Claims 3,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ball** in view of **Tran** (US 6,202,060).

As to Claims 3,35, **Ball** teaches the system of claim 1 wherein the modalities comprise electronic mail, facsimile transmission, public telephone network, cellular telephone, pager, and postal mail;

Ball does not teach the following limitations:

“cellular telephone, pager and postal mail”

However, it is obvious that **Ball** suggests the limitations. This is because **Ball** teaches message delivery to recipients (Figure 3). **Tran** teaches the limitations (Col. 7, lines 53-63 and Col. 37, lines 37-40). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add cellular, pager and postal mail capabilities to **Ball's** invention for delivering messages as taught by **Tran's** invention in order to provide delivery of messages using different media.

9. Claims 4 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ball** in view of **Tran** and further in view of **Brown**.

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As to Claims 4,36, **Ball** teaches the system of claim 3 wherein the condition associated with telephone transmission is non-receipt of the message, the system further comprising:

Ball does not teach the following limitation:

“means for detecting said non-receipt”

However, it is obvious that **Ball** suggests the limitation. This is because **Ball** teaches receiving a subset of responses (Col. 23, lines 12-14). **Brown** teaches unsuccessful notification of message delivery (Figure 6, label 616). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add unsuccessful delivery capability to **Ball**'s invention in order to provide user control of message delivery.

10. Claims 8, 10-11, 13-15, 23-29, 39, 41-42, 44-46 and 53-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ball** in view of **Sonnenfeld** (US 6,112,049).

As to Claims 8,15,39,46, **Ball** teaches the system of claim 1 further comprising:

a. means facilitating response to a received message, the message server receiving the responses; and

b. a memory for collecting records of the responses,

Ball does not teach the following limitation:

“the interface being configured to tabulate and present the records in a summary format”

However, it is obvious that **Ball** suggests the limitation. This is because **Ball** teaches collecting recipient information (Figure 8, label 807). **Sonnenfeld** teaches performing group and

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individual statistics on collected recipient information (Col. 2, lines 38-45). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add statistics capability to **Ball's** invention as taught by **Sonnenfeld's** invention in order to provide feedback to message senders.

As to Claims 10-11,13-14, 41-42,44-45, **Ball** teaches the system of claim 1 wherein the interface is further configured to receive, from a message sender, a global list of potential message recipients and criteria associated with each potential recipient, the interface facilitating searching of the list based on specified criteria and identification of potential recipients whose recipient criteria match the specified criteria (Col. 23, lines 39-49);

Ball does not teach the following limitation:

“global list”

However, it is obvious that **Ball** suggests the limitation. This is because **Ball** teaches user the Internet for delivering messages to recipients (Figure 1). **Sonnenfeld** teaches global tests (global lists) (Col. 2, lines 58-65). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add statistics capability to **Ball's** invention as taught by **Sonnenfeld's** invention in order to provide message delivery to global users.

As to Claims 23,29,53,59, with respect to Figures 1-4, **Ball** teaches a messaging system comprising:

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- a. a message server comprising a plurality of communication modalities for transmitting messages (Figure 1, label 108);
- b. an interface for receiving (i) a message inviting a response, (ii) a plurality of recipients, and (iii) for each recipient, a designation of at least one of the communication modalities (Figure 2, label 108);
- c. a routing facility, responsive to the designation, for causing transmission of the message by means of the designated modalities (Col. 6, lines 45-53), wherein
- d. the communication modalities are configured to remotely receive the responses from the recipients (Col. 6, lines 45-53); and

Ball does not teach the following limitation:

“e. the interface is configured to present a tabulated version of the responses”

However, it is obvious that **Ball** suggests the limitation. This is because **Ball** teaches collecting recipient information (Figure 8, label 807). **Sonnenfeld** teaches performing group and individual statistics on collected recipient information (Col. 2, lines 38-45). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add statistics capability to **Ball's** invention as taught by **Sonnenfeld's** invention in order to provide feedback to message senders.

As to Claims 24,54, **Ball** teaches the system of claim 23 wherein a plurality of modalities is designated and, for at least some of the modalities, the message comprises instructions facilitating later response by the recipient via at least one specified communication modality (Figure 5).

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As to Claims 25,55, **Ball** teaches the system of claim 24 wherein the message server comprises a web server and at least one specified communication modality is a web page transmitted to the user and facilitating response selection and transmission of the response to the web server (Col. 18, lines 2-10).

As to Claims 26,56, **Ball** teaches the system of claim 24 wherein the message server comprises a telephony server and at least one specified communication modality is telephone contact with the telephony server, the telephony server being configured to receive the response (Col. 25, lines 29-35).

As to Claims 27,57, **Ball** teaches the system of claim 26 wherein the response is received by means of touch-tone pulses (Col. 25, lines 29-35).

As to Claims 28,58, **Ball** teaches the system of claim 26 wherein the response is received by means of speech recognition (Col. 25, lines 29-35).

11. Claims 17-18, 20-21 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ball** in view of **Brown** and further in view of **Rogers et al.** (US 5,946,386).

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As to Claims 17-18, 20-21, 48-51, **Ball** teaches the system of claim 16 wherein the scheduling criteria include at least one of:

Ball does not teach at least one of the following limitations:

- (a) blackout periods during which the at least one designated modality may not be used and
- (b) time windows during which the at least one designated modality may be used, the routing facility causing transmission to occur at a time consistent with the scheduling criteria;

However, it is obvious that **Ball** suggests the limitations. This is because **Ball** teaches sending messages to plural recipients (Figure 3). **Rogers** teaches the limitations (Col. 38, lines 41-52). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add time window capability to **Ball's** invention as taught by **Rogers'** invention in order to provide receipt of particular messages.

12. Claims 22,52 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ball** in view of **Brown** and further in view of **Sonnenfeld**.

As to Claims 22,52, **Ball** teaches the system of claim 1 wherein the interface is further configured to receive, from a message sender, a global list of potential message recipients and criteria associated with each potential recipient, the routing facility being responsive to the scheduling criteria and causing messages to be delivered to designated ones of the potential recipients in accordance with the scheduling criteria associated therewith (Col. 23, lines 39-49);

Ball does not teach the following limitation:

“global list”

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However, it is obvious that **Ball** suggests the limitation. This is because **Ball** teaches using the Internet for delivering messages to recipients (Figure 1). **Sonnenfeld** teaches global tests (global lists) (Col. 2, lines 58-65). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add global capability to **Ball's** invention as taught by **Sonnenfeld's** invention in order to provide message delivery to global users.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pepe et al. (US 5,742,905) teach message delivery using different media types.

Goldman et al. (US 6,134,235) teach selecting POTS or packet networks for transmitting messages.

Klein (US 5,479,411) teaches composing integrated voice and fax messages from received e-mail messages.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
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or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 306-0377 (for customer service assistance)

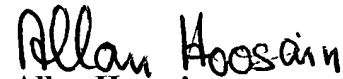
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
9/3/02

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.